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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,566	02/11/2004	James J. Estrada	07844-620001	6004
21876 7590 09/05/2008 FISH & RICHARDSON P.C. P.O. Box 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
LO, SUZANNE				
ART UNIT		PAPER NUMBER		
2128				
NOTIFICATION DATE		DELIVERY MODE		
09/05/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/777,566

Applicant(s)

ESTRADA, JAMES J.

Examiner

SUZANNE LO

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8, 10-25, 27-34 have been presented. The Request for Continued Examination submitted 05/27/08 has been acknowledge.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8, 10-25, 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 17-18, and 34 recite the limitation "the color information of the image" in the final limitations. There is insufficient antecedent basis for this limitation in the claims.

All dependent claims are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-8, 10-25, 27-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The following analysis is required in order to determine whether the claimed invention complies with 35 USC 101. See MPEP 2106:

Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO

personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (i.e., process, machine, manufacture, or composition of matter).

Determine Whether the Claimed Invention Falls Within 35 U.S.C. 101 Judicial Exceptions – Laws of Nature, Natural Phenomena and Abstract Ideas

Determining whether the claim falls within one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. 101 (i.e., process, machine, manufacture, or composition of matter) does not end the analysis because claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection (citations omitted).

Determine Whether the Claimed Invention Covers Either a 35 U.S.C. 101 Judicial Exception or a Practical Application of a 35 U.S.C. 101 Judicial Exception

Determine Whether the Claimed Invention is a Practical Application of an Abstract Idea, Law of Nature, or Natural Phenomenon (35 U.S.C. 101 Judicial Exceptions)

For claims including such excluded subject matter to be eligible for patent protection, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon (citations omitted). A claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it:

- (A) “transforms” an article or physical object to a different state or thing; or
- (B) otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

Determine Whether the Claimed Invention Preempts a 35 U.S.C. 101 Judicial Exception (Abstract Idea, Law of Nature, or Natural Phenomenon)

Even when a claim applies a mathematical formula, for example, as part of a seemingly patentable process, USPTO

personnel must ensure that it does not in reality "seek[] patent protection for that formula in the abstract."
... "Phenomena of nature, though just discovered, *mental processes, abstract intellectual concepts* are not patentable, as they are the basic tools of scientific and technological work."... One may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent "in practical effect would be a patent on the [abstract idea] itself." ... "To hold otherwise would allow a competent draftsman to evade the recognized limitations on the type of subject matter eligible for patent protection." ... Thus, a claim that recites a computer that solely calculates a mathematical formula ... or a computer disk that solely stores a mathematical formula is not directed to the type of subject matter eligible for patent protection (citations omitted).

Claims 1-8 and 10-17 are directed towards a computer-implemented method consisting solely of mathematical algorithms, which are not proper process claims as they are not tied to a practical application.

Claims 18-25 and 27-34 are directed towards computer implemented mathematical algorithms with no practical application.

Additionally, claims 1-8, 10-25, and 27-34 are practical preemption; while the mathematical algorithm is attached to a general purpose computer, the claims preempt all applications of the algorithm.

Allowable Subject Matter

4. Claims 1-8, 10-25, and 27-34 are directed to allowable subject matter. However, until the outstanding 35 U.S.C. 101 and 112 issues have been resolved, the reasons for allowance will be held in abeyance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUZANNE LO whose telephone number is (571)272-5876. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on (571)272-2297. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamini S Shah/
Supervisory Patent Examiner, Art Unit 2128

Suzanne Lo
Examiner
Art Unit 2128

/SL/
08/29/08